

## REMARKS

Claims 19-29 and 32-43 are pending in the present application.

Reexamination of the application, reconsideration of the rejections and objections and withdrawal of the finality of the Office Action are respectfully requested in view of the following remarks.

### ***I. Interview***

Applicants sincerely thank Examiner Loewe for the helpful telephonic interview conducted November 24, 2008, between the Examiner and the undersigned attorney. During the interview, the data in Table 3 was specifically pointed out by the attorney. Other issues discussed include the extent of searching performed on the claimed genus.

### ***II. Claim Objections***

In view of the arguments set forth below, Applicants respectfully request that the objection to claims 19, 23-27, 32 and 38-43 be withdrawn and the search extended.

### ***III. Claim Rejections Under 35 U.S.C. § 103***

Claims 19, 26, 27, 32 and 38-41 have been rejected under 35 U.S.C. § 103(a) for allegedly being obvious over van Hes et al ("the '157 patent"). OA pp. 3-4. Applicants respectfully traverse this rejection.

To summarize the rejection, with regard to the data submitted in a Declaration by one of the present inventors, the Office Action states that: "The evidence provided does not persuasively indicate unexpected results because the differences disclosed (eg Table 2; 76-85 vs. 56-65; 100 vs. 76-85) is [sic] not considered to be significant." Id., p. 3.

By rejecting the non-elected compound, 2-cyano-3-methyl-N-methylbenzenesulfonamide based on the data in Table 2 of the Declaration, and overlooking that data in Table 3 of the Declaration, the Office Action is requiring that the compound be superior in all properties. It is clearly improper to require that the presently claimed compounds demonstrate superior activity in every property. The MPEP at § 716.02(a) cites, *inter alia*, *In re Chupp*, 816 F.2d 643, 646 (Fed. Cir. 1987):

(Evidence showing that the claimed herbicidal compound was more effective than the closest prior art compound in controlling quackgrass and yellow nutsedge weeds in corn and soybean crops was sufficient to overcome the rejection under 35 U.S.C. 103, even

though the specification indicated the claimed compound was an average performer on crops other than corn and soybean.). See also *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (unexpected superior therapeutic activity of claimed compound against anaerobic bacteria was sufficient to rebut prima facie obviousness even though there was no evidence that the compound was effective against all bacteria).

Further, the property and the compound are inseparable, and *Chupp* discusses the breadth due a claim to a compound, which has a superior property:

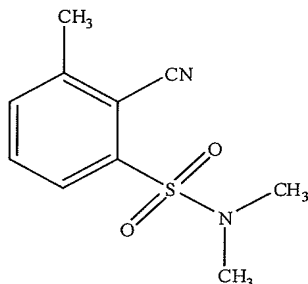
To rebut a prima facie case of obviousness, Ackermann submitted evidence that the claimed compound was ten times more effective on polyester fibers than were the closest prior art compounds. The specification stated, however, that the claimed compound could be used as an optical brightener on a variety of materials. In affirming the examiner's rejection, *the board said that the evidence of superiority on polyester fibers did not support the breadth of the claim, which covered the compound for all brightening purposes. The Court of Customs and Patent Appeals reversed, holding that the evidence of superiority on polyester fibers pertain[ed] to the full extent of subject matter being claimed (i.e., the compound per se)*, and was enough to show that the compound possessed an unexpected difference in properties over the prior art.

*Chupp*, 816 F.2d 646. (Emphasis added.) (Internal quotations omitted.) Table 3 shows that the compound possesses 56-65 % activity against bean aphid at 10 ppm and 76-85 % activity at 100 ppm, versus 0 % activity by the closest prior art compound at the same concentrations. On their face, these data show a significant increase of 56 to 85 % in this property over the prior art. Applicants have thus shown that the compounds are patentable.

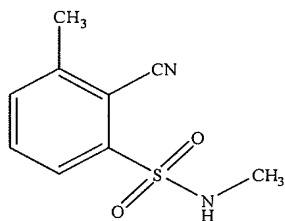
With regard to Applicants' data showing activity of representative compounds against whitefly, spider mite and ants, the Office Action misinterprets the reasons why these data were submitted. Applicants submitted these data not to show a sole reason for patentability. Rather, these data were submitted in conjunction with other evidence, including data showing an unexpectedly superior property. All evidence must be considered in determining the ultimate question of patentability. *In re Dillon*, 919 F.2d 688. Applicants respectfully request that all evidence, including the data in Table 3 of the Declaration, be considered, and that the rejections be withdrawn in light thereof.

For convenience, the structure of 2-cyano-3-methyl-N-methylbenzenesulfonamide and the closest prior art compound, as well as the data from Table 3 and the rating scale from the Declaration submitted on June 2, 2008, are reproduced below:<sup>1</sup>

From page 2 of the Declaration, the compound, 2-cyano-3-methyl-N-methylbenzenesulfonamide (identified as "Example 29") has the following structure:



From page 3 of the Declaration, the prior art compound (identified as "Comparative A") has the following structure:



From page 4 of the Declaration, the data in Table 3 are as follows:

Table 3: Activity against Bean Aphid

	Activity Rating	
	10 ppm	100 ppm
Example 29	5	7
Comparative A	0	0

From page 3 of the Declaration, the rating scale (0-9) is based upon a reduction of live population vs. an untreated control. The scale is copied below:

Rating	% Reduction Compared to Check
9	100
8	86-99

<sup>1</sup> Applicants note that the Declaration is not limited to the shown compound. Rather, additional compounds of the claimed genus are also shown to have at least one superior property.

7	76-85
6	66-75
5	56-65
4	46-55
3	36-45
2	26-35
1	10-25
0	No effect (< 10%)

**IV. Obviousness-Type Double Patenting**

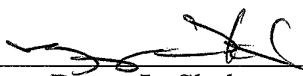
The Office Action maintains that claims 19, 23-27, 31 and 32 are unpatentable over claim 35 of co-pending Application No. 11/909,447, and that claims 19, 23-27, 31 and 32 are unpatentable over claim 35 of co-pending Application No. 11/791,398. Applicants respectfully request that the rejections be withdrawn in this application, which is the first-filed application. When the present claims are found allowable, the Examiner should assess whether the rejection could then be applied to the later-filed applications.

For the foregoing reasons, claims 19-29 and 32-43 are considered allowable. A Notice to this effect is respectfully requested. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

Respectfully submitted,

BRINKS HOFER GILSON & LIONE

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